



# UNITED STATES PATENT AND TRADEMARK OFFICE

9/11  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,703	03/16/2001	Kenneth P. Weiss	W0537/7006	7223
7590	09/16/2005		EXAMINER	
JOHN N. ANASTASI C/O LOWRIE, LANDO & ANASTASI, LLP ONE MAIN STREET RIVERFRONT OFFICE PARK CAMBRIDGE, MA 02142			DADA, BEEMNET W	
			ART UNIT	PAPER NUMBER
			2135	
			DATE MAILED: 09/16/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/810,703	WEISS, KENNETH P.
	Examiner	Art Unit
	Beemnet W. Dada	2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 August 2005.
- 2a) This action is FINAL.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,4,8-16 and 19-43 is/are rejected.
- 7) Claim(s) 2,3,5-7,17 and 18 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____



### **DETAILED ACTION**

1. This office action is in reply to an after final amendment filed on August 22, 2005. Claims 1-43 are pending.
2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Response to Arguments***

3. Applicant's arguments filed on August 22, 2005 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "the query biological information". There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 4, 8-9, 13, 15-16, 19-20 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Soong US Patent 6,941,271 B1.

8. As per claims 1, 4, 8-9, 13, 15-16, 19-20 and 43 Soong teaches a secure registry system including:

    a database containing selected data on each of a plurality of entities (i.e., database 112) [column 5, lines 2-11], a code being stored with at least selected portions of said data for at least selected said entities restricting access to said selected portions to entities defined by each said code (i.e., limited access) [column 11, lines 5-47] ;

    an identity mechanism which permits each entity to securely identify itself to the system [column 6, lines 14-31 and column 11, lines 11-31];

    an input mechanism which determines if an identified entity is authorized to enter data into the database, and permits an authorized entity to enter data into the database [column 6, lines 35-49 and column 7, lines 20-51];

    an access mechanism which permits access requests to be made to said database, each such request including an indication of data requested (i.e., patient record) and at least one of a coded indication of the entity requesting the access and the status of such entity (i.e., record access with identification wherein limited or full access is provided based on the status (for example professional, family or friend) of the requestor) [column 11, lines 11-43]; and

an entitlement mechanism, including at least in part said identity mechanism, which determines from at least one of provided coded indication of entity and coded indication of entity status whether the entity is entitled to access the requested data, the mechanism granting access to the requested data if the entity is entitled and denying access if the entity is not entitled [column 11, lines 30-49].

9. Claims 10-12, 14 and 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Berkley et al. US Patent 6,546,005 B1 (hereinafter Berkley).

10. As per claim 10-12, 14 and 21-23 Berkley teaches a secure registry system for entities, each of which is identified by a multi-character public code, the system including:

a database from which the public code (i.e., for example user identifier, user's name) for each entity may be obtained [column 7, lines 37-50 and column 10, lines 25-33]; and

a processor at a provider of services for entities, said processor including a mechanism for mapping each received public code to data required by the provider in order to provide the services [column 10, lines 25-35, 53-65], receiving the public code for an entity on whose behalf services are to be provided and using the corresponding mapped data to perform the services [column 10, lines 35-50 and column 11, lines 5-17].

11. As per claim 14, Berkley teaches a secure registry system including:

a database containing biographical data on a plurality of individuals [column 7, lines 37-50];

a query mechanism by which an entity trying to find an individual can input to the system a query containing selected biographical data on the individual [column 10, lines 25-32];

a response mechanism operative in response to a query for providing to the entity selected information on individuals in the system matching the query biographical information [column 10, lines 25-44]; and

a contact mechanism (for example by email, fax or telephone) by which the entity making the query can contact a matching individual only through the system, no contact information being provided to the entity [column 10, lines 45-50, column 11, lines 5-17].

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 24-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berkley et al. US Patent 6,546,005 B1 in view of Bernstein US Patent 5,915,023.

14. As per claims 24-43, Berkley teaches the method/system as applied above. Berkley is silent on the act of mapping received public code and using the mapped data to perform services comprises receiving credit card information about the entity to perform the services, wherein the act of mapped data comprises receiving a validation or denial of the credit card transaction without actually receiving the credit card number of the entity. However Bernstein teaches an automatic account controller for remotely arranging for transfer of value (see abstract) including an identification information comprises personal information (for example, email address, telephone number) [column 4, lines 3-9], further comprising of mapping received

public code and using the mapped data to perform services comprises receiving credit card information about the entity to perform the services, wherein the act of mapped data comprises receiving a validation or denial of the credit card transaction without actually receiving the credit card number of the entity [column 6, lines 34-59 and column 7, lines 46-67]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Bernstein within the system of Berkley in order to enhance security of the system.

***Allowable Subject Matter***

15. Claims 2, 3, 5-7, 17 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beemnet W. Dada whose telephone number is (571) 272-3847. The examiner can normally be reached on Monday - Friday (9:00 am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Beemnet Dada

September 13, 2005



KIM VU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2135